

REMARKS/ARGUMENTS

Claims 1, 2 and 6-27 are pending in the application. All claims currently stand rejected. In response to the present Office Action, no claims are amended or cancelled. No new claims are added. Thus, upon entry of this amendment claims 1-2 and 6-27 are pending in the application. No new matter is added.

RESPONSE TO REJECTIONS UNDER 35 U.S.C. §103(a)

The Examiner has rejected claims 1, 2 and 6-27 under 35 U.S.C. §103(a) as being unpatentable under Morrison et. al., U.S. Patent 6,433,068. Specifically the examiner stated:

“This patent shows gel compositions which can incorporate applicants’ instantly claimed ester alcohol ether or naturally occurring fat or oil. See specifically column 4 lines 6+. This patent renders obvious the formulation of a gel composition wherein the composition is substantially free of mineral oils. Column 4 lines 43+ show that the mineral oil is but an optional selection from a list of hydrocarbons. It would be prima facie obvious to one of ordinary skill in the art to select one of the hydrocarbons from this list which is not a mineral oil and formulate a gel composition as claimed. The motivation for one of ordinary skill in the art to do so stems from the fact that the patent expressly shows ingredients which are not mineral oils and teaches one of ordinary skill in the art that they are functional in the formulation of a gel composition.”

Office Action dated April 22, 2003 – Pages 2-3.

RESPONSE TO REJECTIONS UNDER 35 U.S.C. §103(a)

The Applicants have considered the Examiner’s comments and disagree that the applied art renders the current claims unpatentable. The Applicants reasons follow.

APPLICABLE LAW

When subject matter, disclosed but not claimed, in a patent or patent application is claimed in a later application having at least one common inventor as the patent, the patent or patent application publication is a valid reference available as prior art under 35 U.S.C. §102(a), (e), or (f) unless overcome by affidavit or declaration by a common inventor under 37 CFR §1.132 that he or she conceived or invented the subject matter disclosed in the patent or published application. *MPEP 716.10*. Such a declaration from the common inventor regarding the subject matter disclosed in the patent or published patent application will be accepted as establishing inventorship. *In re DeBaun*, 687 F.2d 459, 463; 214 USPQ 933, 936 (CCPA 1982). Under these circumstances the patent or patent application is no longer applicable. *MPEP 716.10*.

APPLICATION OF THE LAW

The Applicants respectfully submit that the *Morrison et al.* reference (*Morrison*) is not applicable because the currently claimed invention was invented by inventors that are common to both the *Morrison* reference and the present application. The *Morrison* reference identifies David Morrison, Lin Healy, and Robert Ray as inventors. But Lin Healy and David Morrison are also inventors named on the present application. The Applicants have provided, herewith as Appendix A, a declaration under 37 CFR §1.132 by Lin Healy (the Healy Declaration) establishing that she and David Morrison are the inventors of the portion of *Morrison* disclosing ester gel compositions. Thus, the Healy Declaration establishes that the common inventors, Lin Healy and David Morrison, conceived or invented the subject matter disclosed in *Morrison*. Therefore, *Morrison* is not a proper reference. MPEP 716.10. The Applicants respectfully request that the rejection be withdrawn.

CONCLUSION

The Applicants have addressed all of the Examiner's rejections. In conjunction with the arguments above, the Applicants believe that the application is now in condition for allowance and respectfully request that the Examiner grant such an action. If any questions or issues remain, the resolution of which the Examiner feels will be advanced by a conference with the Applicants' attorney, the Examiner is invited to contact the attorney at the number noted below.

Should there be any additional fees required, please charge such additional fees to Deposit Account 10-0447, reference 42133-00009USPT (ABDON).

Respectfully submitted,

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